REMARKS

This amendment responds to the final Office Action mailed on November 26, 2007. The shortened statutory period for response is set to expire on February 26, 2007. Accordingly, applicants respectfully submit that this response is being filed within two (2) months of the mailing of the final Office Action.

Applicants would like to express their appreciation of the courtesy extended by Examiner Vig in prior telephonic discussions with applicants' undersigned attorney in which Examiner Vig suggested that independent claims 1 and 14 would be allowable over the cited prior art if they were amended to further clarify that the preferred communication format of each of the plurality of recipient parties of the business transaction was determined using information interpretted at the transaction service server. Thus, the applicants have amended independent claims 1 and 14 above to recite that the the transaction service server determines the preferred communication format of each of the plurality of recipient parties of the business transaction by interpreting communication format indicators associated with each of the plurality of recipient parties received in an electronic file format at the transaction service server.

Claims 1-10, 14-20 and 22-24 remain pending in the present application, and applicants believe these claims are in proper condition for allowance for the reasons set forth below. In summary, the combination of cited prior art fails to teach or suggest 1) a transaction service server determining a preferred communication format for each of the recipient parties for an electronic business transaction document by interpreting communication format indicators associated with each of the plurality of recipient parties contained in the electronic business transaction document received in an electronic file format at the transaction service server (as recited in independent claims 1 and 14 as amended above), and 2) an electronic business transaction document containing address information and a preferred communication format indicator for each of the plurality of recipient parties of the business transaction that is automatically retrieved from an electronic address book stored at a client computer (as recited in independent claim 19).

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Claim Rejections - 35 U.S.C. § 112

Claims 1-10 and 14-18 are rejected under 35 U.S.C. § 112, second paragraph, as being vague and indefinite, because it is asserted in the Office Action that it is not clear from these claims how the transaction service server will determine the preferred communication format for each of the recipient parties of the business transaction. By the above amendments, independent claims 1 and 14 have been amended to recite that the the transaction service server determines the preferred communication format of each of the plurality of recipient parties of the business transaction by interpreting communication format indicators associated with each of the plurality of recipient parties received in an electronic file format at the transaction service server. The present specification describes in paragraph [0076] that the transaction service server transmits the electronic business transaction document "to each destination party in the communication format associated with the party." For example, the communication format indicators are determined by the transaction service server based on the message type attributes or the "messageType tag" included in the electronic business transaction document received by the transaction service server. (*See* paragraphs [0072] and [0076] of the present specification).

In a network transaction portal implementation as described in paragraph [0078] of the present specification, electronic business transaction document 54' is described as optionally being a different electronic file format (e.g., HTML) or the same electronic file format (e.g., XML). In the various embodiments, the transaction service server will receive a communication format indicator in an electronic file format based on the electronic file format of the electronic business transaction document. The transaction service server will then interpret the received communication format indicators to determine the preferred communication formats for each of the plurality of recipient parties of the business transaction. Claims 1 and 14 have been amended to clearly recite this feature, and it is respectfully submitted that claims 1-10 and 14-18 now particularly point out and distinctly claim the subject matter which applicants regarding as the invention. Applicants respectfully request reconsideration and withdrawal of the § 112 rejection.

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Claim Rejections - 35 U.S.C. § 103(a)

Claims 1, 2, 7-10, 14, 18-20 and 23 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over IBM Corporation Product Facsimile Support/400 ("IBM") in view of U.S. Patent No. 6,424,426 issued to Henry ("Henry") and U.S. Patent No. 6,775,711 issued to Akimoto ("Akimoto"). Claims 3-6, 15-17, 22 and 24 were rejected under 35 U.S.C. U.S.C. § 103(a) as being obvious over IBM in view of Henry and Akimoto and further in view of NetGram.com ("NetGram"). Applicants traverse the Examiner's rejections for the following reasons.

Independent Claims 1 and 14 Recite that the Server Computer Determines the Preferred
Communication Format of the Recipient Parties

Independent claims 1 and 14 as amended above recite an electronic business transaction service method and software for conducting a business transaction over a computer network and sending a business transaction document in a preferred communication format of a recipient party, wherein the transaction service server computer determines the preferred communication format of each of the plurality of recipient parties of the business transaction.

It is admitted in the Office Action that "IBM in view of Henry does not explicitly teach capability for determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction." *See first full paragraph on page 5 of the Office Action.* The Office Action cites Akimoto to cure the deficiency of determining a preferred communication format for each of the plurality of recipient parties of the business transaction, where Akimoto is cited as teaching this feature.

However, Akimoto fails to teach or suggest determining at the transaction service server computer a <u>preferred communication format</u> for each of the plurality of recipient parties of the business transaction and then sending the business transaction document in the preferred communication format of a recipient party. The Office Action cites Akimoto's Figure 8 and the associated description as teaching a determination of preferred communication formats. Figure 8, and the description of Figure 8, discuss how various identification characters are used to

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manipulate the content being transmitted. The processing referred to in Akimoto (which is triggered by various identificiation characters) is for **content processing**, such as signature processing, encryption processing, JPEG conversion, etc.

Figure 8, and the description of Figure 8, discuss how various identification characters are used to manipulate the content being transmitted. "The mail address analize section 308 sends the analysis result to the determination section 309 [which] determines whether or not encryption processing is performed in later steps based on the analysis result." *See* Akimoto, Column 8, Lines 17-21 (describing of Figure 8). "In other words, when the mail adddress analyze section 308 detetects characters "A" to "C" after the identifirfcation character "@" the determination section 309 determines that processing according with these charactes is executed." *See* Akimoto, Column 8, Lines 30-35 (describing of Figure 8). Figure 7 is brings further understanding to Akimoto's identification characters. Figure 7 shows a column of various identification characters and a column of corresponding content processing operations.

"The identification character/processing table is stored in RAM 209. Here, as identification characters, characters A to C are used in addition to "@", and processing contents are determined in association with these identification characters, respectively. When the identification "A" is added, signature processing is carried out. When the identification "B" is added, encryption processing is carried out. When the identification "C" is added, JPEG conversion is carried out. The JPEG conversion is herein referred to processing for converting the MH file to the JPEG file." *See* Akimoto, Column 7, Lines 25-35 (describing of Figure 7).

After the Akimoto server executes content processing associated with the identification characters A to C, it then transmits the processed content according to the same transfer protocol, irregardless of the type of the content processing that was performed. For example, see column 9, lines 44-47 of Akimoto which recites that the server only performs processing of the content (i.e., image data) according to the identification characters, but thereafter sends the processed image data in accordance with an e-mail transfer protocol.

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It is respectfully submitted that the communication format remains unchanged in Akimoto (e.g., the communication format is e-mail transfer protocol), whereas it is the content that is included in such e-mail transfer protocol communication format that can be altered. Furthermore, IBM also teaches that the same exact communication format is used for all communications, namely industry standard CCITT Group 3 fax format. IBM further indicates that it is an important characteristic of its Fasimile Support/400 outbound process that all pages are converted to the CCITT Group 3 fax format. *See pages 4-5 of IBM.* As described in paragraph [0003], the use of such industry-wide standards for all communications is a limitation on business that the electronic transacton service system of the present application is designed to avoid.

To the contrary of the Akimoto and IBM teachings, independent claims 1 and 14 recite that transaction service server computer determines a preferred <u>communication format</u> for each of the plurality of recipient parties of the business transaction. These preferred communication formats are further determined by interpreting communication format indicators associated with each of the plurality of recipient parties received in an electronic file format at the transaction service server. Independent claims 1 and 14 further recite that it is determined whether the preferred format is either a computer communication format or a non-computer communication format, where the business transaction document is sent to the recipient in the preferred communication format.

As set forth above, it is admitted in the Office Action that the combination of IBM and Henry fails to teach capability for determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction. It can further be seen from the above that Akimoto fails to cure this deficiency. As such and as discussed during the Examiner Interview, the combination of IBM, Henry and Akimoto fails to teach or suggest <u>a transaction server determining a preferred communication</u> <u>format</u> for each of the plurality of recipient parties of the business transaction. It is respectfully submitted that the obviousness rejection of independent claims 1 and 14 and their respective

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dependent claims cannot be maintained in view of the combination of IBM, Henry and Akimoto, and applicants submit that such claims are now in proper condiction for allowance.

Independent Claim 19 Recites Automatically Retrieving Address Information and a Preferred Communication Format Indicator from an Electronic Address Book

It is initially noted that independent claim 19 recites an electronic business transaction service method in which the transaction service server computer determines the preferred communication format of each of the plurality of recipient parties of the business transaction. As it set forth above in distinguishing independent claims 1 and 14 over such prior art in view of this feature, it is respectfully submitted that this feature is not taught or suggested by the combination of cited prior art. Thus, applicants believe that independent claim 19 is similarly patentable over the cited prior art for the same reasons set forth above in connection with distinguishing independent claims 1 and 14 over this same prior art.

Further, it respectfully submitted that independent claim 19 is separately patentable of the cited prior art of record, because the cited prior art fails to teach or suggest an electronic business transaction document containing address information and a preferred communication format indicator for each of the plurality of recipient parties of the business transaction that is generated at a client computer by automatically retrieving this information from an electronic address book stored at a client computer.

It is admitted in the Office Action that IBM does not explicitly teach a preferred communication format indicator in a business transaction document indicating a preferred communication format for each of the plurality of recipient parties of the business transaction. *See 2nd full paragraph on page 6 of the Office Action.* The Office Action cites Henry as teaching this feature by asserting that Henry teaches that a business document can be sent by a server to a recipient party in their preferred format (fax-to-mail and email-to-fax formats). Applicants traverse this assertion based on the following remarks.

Initially, it is submitted that Henry does not teach a business management software program as disclosed in the present application. Henry discloses tecnology related to the Internet
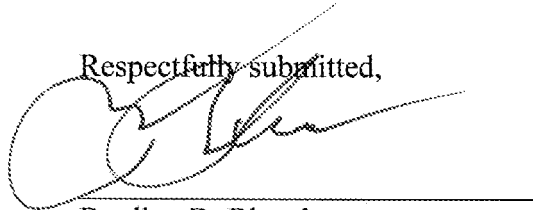
service MongoNet. Henry allows users to manually fill out a form with email addresses and scan such form into a fax machine for transmission to the email addresses provided in the form. It is the user that fills in the email address on the form, not a computer program on a client computer. The document in Henry to be sent is created by a user and the user handwrites of types the email addresses on a form. See Henry Figure 4. "[T]he user fills in the letterboxes, in normal handwriting, with the final email address(es) it wishes to send to, e.g., "john_doe@generic.com". Alternatively, the email address can be printed in a machine-readable format." Therefore, the form is filled out by a user, and is not created by a business management software program. Applicants submit that Henry does not disclose the limitations that the Examiner has indicated to be taught in Henry.

Namely, there is no disclosure in Henry completing an electronic business transaction documents by retrieving addresses and preferred communication formats from an electronic address book on the client computer, as recited in independent claim 19. Again, it is recognized in the Office Action that IBM fails to explicity teach preferred communication format indicators. Thus, it is respectfully submitted that combination of IBM and Henry fails to teach or suggest creating an electronic business transaction document containing address information and a preferred communication format indicator for each of the plurality of recipient parties of the business transaction that is generated at a client computer by automatically retrieving this information from an electronic address book stored at a client computer. Still further, independent claim 19 recites an electronic business transaction service method in which the transaction service server computer determines the preferred communication format of each of the plurality of recipient parties of the business transaction. These features are not taught or suggested by the combination of IBM, Henry and Akimoto. Thus, applicants submit that all of the limitations of independent claim 19 are not taught ot suggested by the combination of cited prior art, and it is respectfully submitted that independent claim 19 and its respective dependent claims are patentable over the cited prior art of record. Reconsideration is requested.

CONCLUSION

In each case, the pending rejections should be reconsidered in view of the amendments and remarks herein. Applicants believe that this case is in good condition for allowance, and a Notice of Allowance is earnestly solicited. If a telephone or further personal conference would be helpful, the Examiner is invited to call the undersigned at 949-732-6539, who will cooperate in any appropriate manner to advance prosecution. The Commissioner is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to **Deposit Account Number 50-2638**. Please also credit any overpayments to said Deposit Account. Please ensure that Attorney Docket Number 070325-040017 is referred to when charging any payments or credits for this case.

Respectfully submitted,

Date: January 25, 2008

Bradley D. Blanche
Reg. No. 38,387

Customer Number 33717
GREENBERG TRAURIG, LLP
2450 Colorado Avenue, Suite 400E
Santa Monica, CA 90404
Phone: (949) 732-6539
Fax: (949) 732-6501
e-mail: blancheb@gtlaw.com